



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,011	12/14/2000	John Meyer	DEI 00.01	8236

7590 08/13/2003

Kevin M. Drucker
HAYES, SOLOWAY, HENNESSEY,
GROSSMAN & HAGE, P.C.
130 W. Cushing Street
Tucson, AZ 85701

EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,011

Applicant(s)

MEYER ET AL.

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/22/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-92,94-96 and 99-142 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-92,94-96 and 99-142 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This communication is in response to amendment filed 5/22/03.

Response to Amendment

2. Claims 41, 45, 51, 55, 61, 65, 71, 75, 81-92 and 99 have been amended. Claims 93, 95 and 97-98 have been cancelled. New claims 101-142 have been added.

Response to Arguments

3. Applicant's arguments, see p. 44-55, filed 5/22/03, with respect to rejection of claims under 35 U.S.C. §101 and 112 have been fully considered and are persuasive. The objection of claims 85-93 and 95, rejection of claims 85-92 under 35 U.S.C. §101 81-92 and 97 and rejection/objection of claims of 91-92 under 35 U.S.C. §112 have been withdrawn.

Applicant's arguments with respect to rejection of claims 41-100 over prior art references of Powar, Remington and Kitchen patents have been fully considered but are moot in view of the new ground(s) of rejection.

Cited in Prior Action

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in prior Office action.

Claim Rejections - 35 USC § 101

5. Claims 141 and 142 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Claim 141 recite only method step "inserting one or more data elements into a customer name field..". This step can be performed manually via a keyboard by typing in the data element into appropriate location. Therefore, the method step itself fails to render the claimed invention within a technological art. The claims are accordingly rejected under 35 U.S.C. 101.

A second requirement for a claimed to be statutory under 35 U.S.C. 101 is that the *claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result."* State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02.

In the instant case, the claimed invention merely recites a method step recites the only step "inserting one or more data elements into a customer name field.." which fails produce any useful, concrete and tangible result (such as performing a financial transaction such as electronics funds transfer) as required by 35 U.S.C. 101. The claims are accordingly rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3624

7. Claims 99-100 and 141-142 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 99 fails to clearly recite that the scanning apparatus data received in the receiving step ("said scanning apparatus data") are actually generated and encoded on the printed document and subsequently read by (or received by) the scanning apparatus. On the contrary, the claim recites that a standard format is made available to one or more billers (however, the claim does not recite that the biller(s) generate such a printed document). The claim also fails to recite that one or more third parties (which are provided the scanning apparatus as claimed) actually read the data from the printed document to generate "said scanning data" as required in the receiving step.

Furthermore, the "providing" step fails to recite clearly which information is provided to the payment network.

In conclusion, the deficiencies relate to providing proper linkage of the claim limitations to each other. In absence of such linkage the claim is rendered indefinite.

Dependent claim 100 also inherits same deficiency.

Claims 141 and 142 recites as preamble, "a method of performing a financial transaction in a network". However, the claim does not recite any limitation(s) which are directed to this objective.

Claim Rejections - 35 USC § 102

8. Claims 41-43, 45-53, 55-63, 65-73, 75-92, 94, 96, 101-103, 105-113, 115-123, 125-133 and 135-140 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Applewhite (US Pub. No.: 2003/0023553) (Applewhite).

Claim 41: Applewhite discloses a bill payment system comprising:

a biller generating at least one invoice for at least one customer, said invoice comprising a unique bar code, said bar code comprising data identifying at least said customer and said biller (para [006] ..forming an indication of a computer-readable indicia, the indication of the computer-readable indicia incorporating, the invoicing party identifier, the financial party identifier, the invoiced party identifier and the amount due for the invoice; and printing the computer-readable indicia on the invoice.);

a scanning apparatus configured to permit a cashier to scan said bar code, said scanning apparatus being capable, based on the identifying data of said bar code, and a payment made to said cashier by said customer in person, of transmitting or initiating transfer of funds to said biller in a predetermined amount and concomitantly transmitting or initiating transmission of data to said biller regarding said payment (para [0014], merchant's existing bar-code reading hardware.. para [0016] ..the total amount not only reflects the amount of the bar-coded bill 200 but also the amounts of the other items purchased. ..the bar code system can generate a transaction record that includes the invoicing party information..., para [0017] ..the bar code system 125 transfers information relating to the bar-coded bill ..to an EFT..If required, this information can be assembled to form a standard electronic funds transfer record).

Claim 42. wherein said funds are transmitted as an electronic funds transfer. (refer to para [0017] transfers information .. electronic funds transfer record.)

Claim 43. wherein said funds are transmitted via the Automated Clearing House. (refer to para [0017], ACH is inherent to electronic funds transfer process).

Claim 45. wherein said data comprises the date and time said customer makes said payment or the place the payment is made. (refer to para [0017] time stamp).

Claim 46. A method according to claim 51, wherein said apparatus is integrated into a point-of-sale system. (refer to para [0017], point-of-sale system ..incorporated into a retail establishment).

Claim 47. wherein said apparatus is in a location selected from the group consisting of : grocery store, .. (refer to para [0017], ..retail establishment).

Claim 48. wherein said bar code is in a location selected from the group consisting of : on the front of said invoice...(refer to Fig. 2, the bar code is shown on the front of the invoice. It should be noted that the location of the bar code has no effect on the functionality of the claimed system).

Claim 49. data identifying said biller is assigned by a central registry authority. (inherent because,.. portions the point-of-sale system 100 are incorporated into a merchant's existing bar-code-reading hardware. As is well known, this requires the bar code (i.e. data thereon) to conform to certain universal protocol. It should be noted that this limitation does not affect the functionality of the claimed system).

Claim 50. said apparatus is configured to print a receipt evidencing said payment. (para 0016) inherent to POS system 100)).

Claim 51. Applewhite teaches a bill payment method comprising: generating an invoice for at least one customer, said invoice comprising a unique bar code, said bar code comprising data identifying at least said customer and said biller (para [006] ..forming an

Art Unit: 3624

indication of a computer-readable indicia, the indication of the computer-readable indicia incorporating, the invoicing party identifier, the financial party identifier, the invoiced party identifier and the amount due for the invoice; and printing the computer-readable indicia on the invoice.);

Permitting a third party to scan said bar code and, based on the identifying data of said bar code and payment made by said customer in person to said third party, to transmit or initiate transmission of funds to said biller in a predetermined amount and concomitantly transmit or initiate transmission of data to said biller regarding said payment (para [0014], merchant's existing bar-code reading hardware.. para [0016] ..the total amount not only reflects the amount of the bar-coded bill 200 but also the amounts of the other items purchased. ..the bar code system can generate a transaction record that includes the invoicing party information.., para [0017] ..the bar code system 125 transfers information relating to the bar-coded bill ..to an EFT..If required, this information can be assembled to form a standard electronic funds transfer record, the bar code is scanned by a merchant who operates the point-of-sale system 100 para [0015]).

Claims 52-53 and 55-60: analyzed per claims 42-43 and 45-50 respectively.

Claim 61: Applewhite teaches a bill payment network comprising a plurality of billers.. and a plurality of third parties.. (Fig. 1a and b: the bill payment network shows a plurality of billers (represented by 145: Invoicing party computer), represented by invoicing party computer 145, note that network allows a plurality of billers to be connected to it a plurality of retail establishments as third parties. Applewhite has shown only single entity of each only for simplicity.). Also note that the third party is represented by cashier in claim 41.

Refer to claim 41 analysis for further discussion of claim limitations.

Claims 62-63 and 65-70: analyzed per claims 42-43 and 45-50 respectively.

Claim 71. Applewhite discloses a bill payment method comprising:

receiving an invoice comprising a unique bar code, said bar code comprising data identifying at least a customer and said biller (para [006] ..forming an indication of a computer-readable indicia, the indication of the computer-readable indicia incorporating, the invoicing party identifier, the financial party identifier, the invoiced party identifier and the amount due for the invoice; and printing the computer-readable indicia on the invoice, note that the invoice is received by the invoiced party);

scanning said bar code (para [0015], the bar-coded bill 200 illustrated ..is read by the bar-code reader);

receiving payment from said customer in person (para[0016] ..the invoiced party can then pay the total amount due by any means acceptable by the merchant); and

based on the identifying data of said bar code and said payment transmitting or initiating transfer of funds to said biller in a predetermined amount and concomitantly transmitting or initiating transfer of data to said biller regarding said payment (para [0014], merchant's existing bar-code reading hardware.. para [0016] ..the total amount not only reflects the amount of the bar-coded bill 200 but also the amounts of the other items purchased. ..the bar code system can generate a transaction record that includes the invoicing party information.., para [0017] ..the bar code system 125 transfers information relating to the bar-coded bill ..to an EFT..If required, this information can be assembled to form a standard electronic funds transfer record).

Claims 72-73 and 75-80: analyzed per claims 42-43 and 45-50 respectively.

Claim 81: Applewhite discloses a payment network comprising:

A payment system adapted to transmit funds to a payee in a predetermined amount based on a payment from a payor in the form of a physical payment instrument and concomitantly transmit data to said payee regarding said payment said data including the date and time said payment system received said payment from said payor (para [0014],

Art Unit: 3624

merchant's existing bar-code reading hardware.. para [0016] ..the total amount not only reflects the amount of the bar-coded bill 200 but also the amounts of the other items purchased. ..the bar code system can generate a transaction record that includes the invoicing party information..., para [0017] ..the bar code system 125 transfers information relating to the bar-coded bill ..to an EFT..If required, this information can be assembled to form a standard electronic funds transfer record, a time stamp includes date and time data (actual date and time of the payment), payment from the payor are received in form of "any means accepted by the merchant such as credit or debit card").

a payee account receivable system adapted to receive said data and to credit an account corresponding to said payor in the amount of said payment as of said date and time said payment system receives said payment from said payor (para [0018] and [0019] refer to functions of the EFT processor 135, ..forms a batch that can be transmitted to the invoicing party computer, inherent in this recitation is the step wherein the invoicing party after receiving the bill payment information crediting the payor in the amount of the invoice).

All limitations of claim 82 are analyzed as per claim 81 analysis. Note that the term "payment system" and "bill paying system" are treated patentably equivalent. Likewise the terms payee and biller are also treated patentably equivalent.

Claim 83: providing said data to a payee account receivable system (para [0018] refer to transmission of the payment data received at the EFT processor to the invoicing party computer 145);

All other limitations of claim 83 are analyzed as per claim 81.

Claim 84: please refer to analysis of claims 82 and 83.

Claim 85, 86, 87 and 88: said payment system is adapted to transmit or initiate transmit or initiate transfer of said data and said funds to said payee in said predetermined amount on the same calendar or business day or next calendar or business day following the date said payment

Art Unit: 3624

system receives said payment from said payor, or within 24 hours or less of the date and time said payment system receives said payment from said payor (para [0018] the EFT collects all bill payment information for that day (or some other time period) and forms a batch that can be transmitted in bulk through the network 140 to the invoicing party computer 145 or to some intermediary (not illustrated in FIG. 1) that is responsible for handling the invoicing party's financial matters).

Claims 89-92: wherein said payment system is adapted to identify the payee said payor is paying by scanning a bar code comprising information corresponding to said payee (refer to discussion of para [0015] regarding functionality of the bar code system 125).

Claim 93: cancelled.

Claim 95: cancelled.

Claim 94 and 96: said biller applies said payment made by said customer against said invoice as of said date and time said customer makes said payment. (para [0018], EFT collects all bill payment information for that day and ..transmitted to the invoicing party..in view of the time stamp recited in para [0017], this step is inherent).

Claims 97-98: cancelled.

Claim 101: refer to analysis of claim 41 with the following additional explanation.

As disclosed in Applewhite, the information of the customer used in transmission of the funds is "invoiced party identifier" i.e. the biller account identifier of the customer.

Claims 102-103 and 105-110 are analyzed as per claims 42-43 and 45-50 respectively.

Claim 111: all limitations are analyzed as per claim 41 where term "cashier" and "third party" are treated as patentably equivalent terms.

Claims 112-113 and 115-120 are analyzed as per claims 42-43 and 45-50 respectively.

Claim 121 is analyzed as per claim 61 and its dependent claims 122-123 and 125-130 are analyzed as per claims 42-43 and 45-50 respectively.

Claim 131: all limitations are analyzed in claim 51 and 99. Dependent claims 132-133 and 135-140 are analyzed as per claims 42-43 and 45-50 respectively.

Claim Rejections - 35 USC § 103

9. Claims 44, 54, 64, 74, 104, 114, 124 and 134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applewhite as discussed Claims 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applewhite as applied to claim 1 above, and further in view of Finocchio (US Pat. 5317135) (Finocchio).

Applewhite fails to disclose that the bar code comprises a plurality of validation levels. Finocchio in the same field of endeavor discloses a bar code comprising a plurality of validation levels.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate a plurality of validation codes into the bar code of because it would ensure accuracy of the invoice data Applewhite system.

Note that this analysis also applies to all other aforementioned claims when the secondary reference of Finocchio is applied to their respective parent claim.

Art Unit: 3624

10. Claims 141 and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Thomas et al. (US Pat. 6,317,745).

Claims 141: Thomas teaches a method of performing financial transaction in a network (refer to Fig. 1), comprising :

Inserting in an electronic funds transfer, inserting one or more elements into a customer name field corresponding to the formal data format specification for a remitted payment record in the Automated Clearing House

wherein said data element comprises one or more of: a local retailer traceback information..the place and/or date and/or time a payment is made.

(Thomas: The trusted third party then performs a lookup of the actual routing number and account number at a central using the supplied ACH UID, substitutes the stored routing and account numbers that correspond to the UID into the ACH message for the special identifier and received UID, respectively, and, once the has been made, completes processing of the through the ACH network in the same manner as any other ACH transaction.)

Thomas fails to recite inserting specific data elements in specific fields as per claimed limitation. However, Thomas clearly teaches the process of inserting (or substituting) one or more elements into a pre-allocated fields of a data format specification for a remitted payment record.

It would have been obvious to one of ordinary skill in the art at the time of invention to insert or more data elements into a customer name field because the resulting payment record would contain most desirable information applicable to the functionality of the payment record, such as increasing the confidentiality of the system as is the case in Thomas.

Claim 142: Inserting in an electronic funds transfer, inserting one or more elements into a customer name field corresponding to the formal data format specification for a remitted payment record in a payment network,

wherein said data element comprises one or more of: a local retailer traceback information..the place and/or date and/or time a payment is made.

(Thomas: The trusted third party then performs a lookup of the actual routing number and account number at a central using the supplied ACH UID, substitutes the stored routing and account numbers that correspond to the UID into the ACH message for the special identifier and received UID, respectively, and, once the has been made, completes processing of the through the ACH network in the same manner as any other ACH transaction).

Thomas fails to recite inserting specific data elements in specific fields as per claimed limitation. However, Thomas clearly teaches the process of inserting (or substituting) one or more elements into a pre-allocated fields of a data format specification for a remitted payment record.

It would have been obvious to one of ordinary skill in the art at the time of invention to insert or more data elements into a customer name field because the resulting payment record would contain most desirable information applicable to the functionality of the payment record, such as increasing the confidentiality of the system as is the case in Thomas.

Art Unit: 3624

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. Draft faxes may be submitted directly to the examiner at (703) 746-5563.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.


Jagdish N. Patel

(Examiner, AU 3624)

8/7/03.